

---

of said grip body from said cap end to said shaft end so as to permit said [the] golf club grip to be consistently positioned in the user's hands for better control of the golf club.

**Claim 7 (previously presented).** An improved golf club grip as defined in Claim 6 wherein said first diameter is approximately in the range of 0.92" - 0.95" and said second diameter is approximately in the range of 0.77" - 0.80".

**Claim 8 (currently amended).** An improved golf club grip as defined in Claim 6 wherein said elongated ridge extends from said [the] cap end to said [the] shaft end of said grip body.

**Claims 9 - 16 (canceled).**

## REMARKS

### General Remarks

As of the date of submission, Applicant has not received a response to Amendment B. Applicant respectfully requests that the Examiner reconsider the Remarks provided by Applicant in Amendment B in light of the additional information provided in Amendment C. Applicant has provided three declarations in lieu of oath pursuant to 37 C.F.R § 1.68 in an attempt to overcome the Examiner's rejections of Claims 1- 8. Further, Applicant has currently amended Claims 1 and 6 to make them easier to understand and to address the Examiner's

rejection of Claims 1 – 8.

Please recall that in Amendment B, Applicant stated that:

- (1) the present invention is **simple** in concept,
- (2) the present invention comprises an improved golf club grip that **combines** certain inventive features and improvements over conventional golf club grips in such a way as to improve the user's performance and the control of his swing,
- (3) the reverse-taper inventive feature of the present invention, whereby the diameter of the grip progressively decreases from the shaft end of the grip to the cap end of the grip, stabilizes the user's swing,
- (4) the linear ridge inventive feature of the present invention improves the user's control by providing a means for consistent positioning of the golf club grip in the user's hands which increases the moment of inertia,
- (5) the combination of these two distinct features in the present invention represents a **substantial improvement** over the prior art and one that could not have been contemplated thereunder because, most importantly,

- 
- (6) had this combination been obvious, **someone else would have recognized the need for the combination and disclosed the combination accordingly!**

The Examiner has rejected Claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent 2001-46568 (hereinafter "2001-46568") in view of Miyasu (U.S. Patent Publication No. 2003/0228929A1 - hereinafter "Miyasu"), Hadge (U.S. Patent No. 5, 906,548 - hereinafter "Hadge") and/or Jacques (U.S. Patent No. 3,837,647 - hereinafter "Jacques"). Applicant has canceled Claims 9-16 and in Amendment B, Applicant addressed each of the Examiners rejections of Claims 1-8. In this Amendment C, Applicant has provided declarations that substantiate Applicant's assertions of non-obviousness. In this Amendment C, Applicant has also amended Claim 1 and Claim 6 to address the Examiner's rejection of Claims 1-8. It is therefore respectfully submitted that the Examiner's bases for rejection under 35 U.S.C. § 103(a) have been overcome.

### **The Rejection of Claim 1**

The Examiner rejected Claims 1, 4-6, and 8 under 35 U.S.C. as being unpatentable over 2001-46568 in view of Miyasu. The Examiner stated:

"Miyasu (Figs. 1,4, Abstract [15]) discloses an alignment means extending

upwardly from an exterior surface from a shaft end to a cap end, an alignment means being an elongated ridge in alignment with a longitudinal axis of a body and an external surface being circular."

The Examiner went on to say that:

"Miyasu does not disclose the external surface being circular throughout the length of the shaft but clearly an artisan designing a grip with a uniform feel would have selected a suitable shape throughout the length in which circular is included. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end and an alignment means being an elongated ridge in alignment with a longitudinal axis of a body in order to assist a golfer in properly aligning a club at impact. In view of the patents of Miyasu, it would have been obvious to modify the grip of 2001-46568 to have a grip having an external surface substantially circular cross-sectional configuration throughout the length of a body to provide a uniform feel along the length of a shaft by having the shape stay the same."

Applicant has amended Claim 1 to make it easier to read and understand and also to claim "an integrally formed (additional structure supported in specification page 8, lines 11-15 and page 13, lines 6-10) alignment means for positioning [the] said grip body in the hands of a user extending upwardly from the exterior surface of said grip body in alignment with the longitudinal axis of said golf club shaft and adapted in cooperation with the increasing diameter of said grip body (additional structure supported in specification page 8, lines 11-15 and page 13, lines 6-10) from said cap end to said shaft end of said grip body whereby [the]

said grip adjacent to said [the] shaft end of said grip body provides an improved grip for the user's hand and better control of the golf club." Applicant respectfully submits that these clarifications further distinguish the present invention from the prior art and as such, overcome the Examiner's rejection of Claim 1.

Applicant stated in Amendment B that the failure of the cited references to (a) specifically describe or infer the critical limitations required by the original and amended claims, or (b) disclose or direct the modification between Applicant's invention and that disclosed in the cited reference, precludes the establishment of the necessary prima facie case of obviousness. Accordingly, Applicant continues to believe that Examiner's rejection of Claim 1 has been overcome.

Further to the foregoing, Applicant has attached three (3) declarations to this Amendment C that attest to the **commercial success** of the present invention.

Applicant maintains that the field in which the present invention resides (golf equipment) is so competitive and lucrative that improvements are implemented as soon as they are recognized. The present invention has enjoyed substantial **commercial success** since it was first introduced because consumers (both recreational and professional golfers) recognize and realize the innovative step of combining the reverse-taper grip and the elongated "reminder rib."

The first declaration addresses the sales figures realized by Applicant since introducing the present invention. Applicant has provided a financial summary to substantiate the assertion of commercial success as well as supporting comments from the four (4) major golf retailers in the United States. The second declaration addresses comments provided by satisfied customers who have used the present invention and can attest to its innovative qualities. Applicant has provided copies of E-mail correspondence to substantiate the assertion of commercial success. The third declaration addresses independent testing of the present invention by an American testing facility and a Japanese testing facility. Applicant has provided a copy of the American facility's Internet web page which discusses the innovative features of the present invention. Applicant has also provided a copy of E-mail correspondence which comments on the proprietary results from the Japanese testing facility.

Because of the enormous world-wide market for golf equipment (tens of millions of recreational golfers worldwide) and the lucrative rewards attendant to the introduction of innovative products, there exists within the industry an intense competition to design, develop, and introduce innovative products that will capture a portion of that enormous world-wide market. Applicant respectfully submits that:

(1) in view of the market for new, innovative golf equipment, and

(2) in view of the financial rewards involved, if combining the two inventive features was obvious as the Examiner suggests, someone would have done so before the Applicant.

2001-46568 issued in 2001 some two years prior to the filing date of Miyasu (02/21/2003). Miyasu was obviously aware of prior art residing in the Japanese patent system (Miyasu specifically cited several examples of Japanese prior art in paragraphs [0004] and [0005]) but apparently ignored or overlooked 2001-46568. Miyasu (Figs. 1 and 2, paragraph 0004 and 0017) consistently refers to “conventional” or “regular” grips but makes no mention of the reverse-taper grip. Applicant respectfully submits that Miyasu, arguably one skilled in the art, did not see the combination of the elongated rib and the reverse-taper grip as “obvious” because the inventive feature of Miyasu was introduced “to provide a grip...which prevents hands from slipping away...and which comforts the hands while the grip is held by the hands.”(paragraph [0007]). Applicant combined the reverse-taper grip and the elongated rib to stabilize the swing and increase the moment of inertia and thereby eliminate the user’s tendency to “slice” the ball. In view of these assertions of non-obviousness, Applicant respectfully submits that the Examiner’s rejection of Claim 1 has been overcome.

---

### **The Rejections of Claims 2 and 3**

The Examiner rejected Claims 2-3 and 7 under 35 U.S.C. § 103 (a) as being unpatentable over 2001-46568 in view of Miyasu as applied to Claims 1, 4-6, and 8 and further in view of Hadge. In response to the Examiner's comments in paragraphs 4 and 6, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 2, 3 and 7 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1. Applicant respectfully submits that Hadge, like 2001-46568 and Miyasu, fails to:

- (1) provide a basis for modifying the grip disclosed by the present invention;
- (2) suggest that such a modification would be successful;
- (3) disclose some beneficial effect inherent in such a modification;
- (4) render obvious the present invention as a whole.

Applicant therefore respectfully submits that the Examiner's rejections of Claims 2, 3, and 7 have been overcome.

### **The Rejection of Claims 4 and 5**

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claims 4 and 5 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.



---

### **The Rejection of Claim 6**

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 6 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

Further, Applicant has amended Claim 6 to make it easier to read and understand and also to claim “ an integrally formed alignment ridge (additional structure supported in specification page 8, lines 11-15 and page 13, lines 6-10) extending upwardly from the external surface of said grip body in alignment with the longitudinal axis of said golf club shaft and adapted in cooperation with the increasing diameter of said grip body from said cap end to said shaft end so as (additional structure supported in specification page 8, lines 11-15 and page 13, lines 6-10) to permit said [the] golf club grip to be consistently positioned in the user's hands for better control of the golf club.”

### **The Rejection of Claim 7**

The Examiner rejected Claims 2-3 and 7 under 35 U.S.C. § 103 (a) as being unpatentable over 2001-46568 in view of Miyasu as applied to Claims 1, 4-6, and 8 and further in view of Hadge. In response to the Examiner's comments in

paragraphs 4 and 6, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 7 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1. Applicant respectfully submits that Hadge, like 2001-46568 and Miyasu, fails to:

- (1) provide a basis for modifying the grip disclosed by the present invention;
- (2) suggest that such a modification would be successful;
- (3) disclose some beneficial effect inherent in such a modification;
- (4) render obvious the present invention as a whole.

Applicant therefore respectfully submits that the rejection of the Examiner has been overcome.

### **The Rejection of Claim 8**

In response to the Examiner's comments in paragraphs 4 and 5, Applicant respectfully requests that the Examiner reconsider his rejection of Claim 8 for the same reasons that Applicant is requesting that the Examiner reconsider his rejection of Claim 1.

### **New Claims 9 through 16**

In response to the Examiner's comments in paragraphs 3, 7 and 8 Applicant has canceled Claims 9 through 16.

**Examiner's Response to Applicant's Arguments**

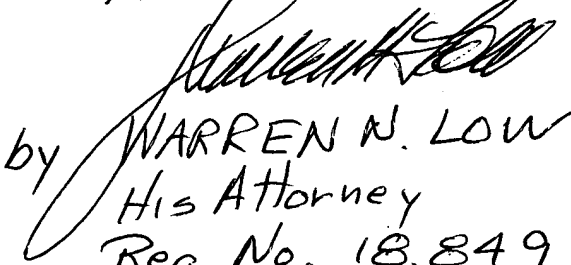
In view of the foregoing, Applicant respectfully requests that the Examiner reconsider Applicant's comments in Amendment B that addressed the Examiner's comments in paragraph 9.

**CONCLUSION**

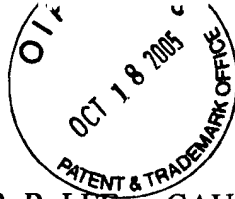
For all the above reasons, Applicant submits that the claims are now in proper form, and that the claims all define subject matter that is patentable over the prior art. Therefore, Applicant submits that this application is now in condition for allowance, which action Applicant respectfully requests.

RESPECTFULLY  
SUBMITTED

R. LEE MILLER

by  WARREN N. LOW  
His Attorney  
Reg. No. 18,849  
Phone: 703-949-4870  
e-mail: LOWANDLOW@AOL.com

Oct. 14, 2005



### **CONDITIONAL REQUEST FOR CONSTRUCTIVE ASSISTANCE**

Applicant has corrected the section that amended the claims of this application so that they are proper, definite, and define novel structure which is also non-obvious.

If for any reason this application is not believed to be in full condition for allowance, Applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P § 2173.02 and § 707.07 (j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,

R. Lee Miller

Applicant and President/CEO

Feel Golf Co., Inc.  
1 Lower Ragsdale Drive  
Building 3 - Suite 700  
Monterey, CA 93940

(831) 647-3110